

Docket No. RSW920030181US1 (7161-121U)

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Gabriel COHEN	:	Confirmation Number: 8004
	:	
Application No.: 10/686,487	:	Group Art Unit: 2176
	:	
Filed: October 15, 2003	:	Examiner: J. Debrow
	:	
For: INDICATING FOCUS IN A PORTAL ENVIRONMENT	:	

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Notification of Non-Compliant Appeal Brief dated December 27, 2007 (hereinafter the Notice).

REMARKS

On page 3 of the Notice, the following was stated:

Regarding Summary of Claimed Subject Matter, Appellant fails to separately identify independent claims involved [sic] in the appeal.

For ease of reference, 37 C.F.R. § 41.37(c)(1)(v), which describes the requirements for the Summary of Claimed Subject Matter section of the Appeal Brief, is reproduced below:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

This subsection includes two sentences, and notably, the second sentence (i.e., starting "[f]or each independent claim ...") refers to claims that include "means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph." However, none of independent claims 1, 6, and 12 include claim language described in the sixth paragraph of 35 U.S.C. § 112. Thus, only the first sentence (i.e., the underlined sentence) of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief.

Since only the first sentence of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief, what is required of the Summary of Claimed Subject Matter section of the Appeal Brief is: (i) a concise explanation of the subject matter in *each* of the independent claims and (ii) the concise explanation refers to the specification and to the drawings. Referring to the last full paragraph on page 2 of the Appeal Brief, independent claims 1 and 12 were concisely

explained,¹ and referring to the paragraph spanning pages 2 and 3 of the Appeal Brief, independent claim 6 was concisely explained. Moreover, each of the concise explanations included several references to the specification by page and line number and to the drawings by reference characters. Thus, Appellants submit that the Appeal Brief meets the requirements of 37 C.F.R. § 41.37(c)(1)(v).

Referring to the specific statement on page 2 of the Notice, Appellant respectfully submit that there is nothing in 37 C.F.R. § 41.37(c)(1)(v) that requires independent claims 1 and 12 be *separately* identified or concisely explained. Put another way, 37 C.F.R. § 41.37(c)(1)(v) does not prevent independent claims 1 and 12 from being concisely explained together. The only instance of the word "separate" found in 37 C.F.R. § 41.37(c)(1)(v) is the following passage:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. (emphasis added)

This passage refers to the separate argument of the dependent claims under the provisions of paragraph (c)(1)(vii) (i.e., the "Argument" section), and not to the separate explanation/identification of the independent claims under the provisions of paragraph (c)(1)(v) (i.e., the "Summary of Claimed Subject Matter" section).

Referring again to 37 C.F.R. § 41.37(c)(1)(v), which requires "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal," Appellant submits that this only requires that each claim be specified and not that each claim be *separately*

¹ Independent claim 12 is essentially identical to claim 1 with the exception that claim 1 is a method claim and claim 12 is a computer product claim for causing a machine to perform the steps recited in claim 1.

specified, as asserted in the Notice. If a subsequent Notification of Non-Compliant Appeal Brief is to be issued, Appellants respectfully request a detailed explanation as to why it is believed that 37 C.F.R. § 41.37(c)(1)(v) requires nearly identical independent claims be *separately* concisely explained in the Summary of Claimed Subject Matter section of the Appeal Brief.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: January 16, 2007

Respectfully submitted,

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CUSTOMER NUMBER 46320